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Attorney Docket No. 103419-0003 (fka J-EPLEY.1002)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Epley, John M.

Serial No. 10/715,871

Examiner: Hoekstra, Jeffrey Gerben

Confirmation No. 5600

Filed: November 17, 2003

Group Art Unit: 3736

For: HEAD-STABILIZED MEDICAL APPARATUS, SYSTEM AND METHODOLOGY

Date: 4 August 2009

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Commissioner for Patents
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Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant respectfully requests review of the rejections in the Final Office Action mailed 27 March 2009 in the above-identified application. The assertions underlying each claim rejection in the office action are based upon clear legal and factual errors, and the cited references fail to teach or suggest all the claim limitations of any claim as detailed herein. As a result, the office action fails to establish a *prima facie* case of unpatentability under 35 §102(b) regarding any of the claims rejected in the final office action. A Notice of Appeal is filed herewith.

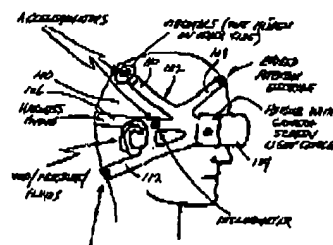
Rejections Under 35 §102(b)

Claims 1, 2, 7, 8, 20, 21, 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Galiana et al. (US 5,942,954).

A claim is anticipated *only if* each and every element as set forth in the claim is found, either *expressly* or *inherently* described, in a single prior art reference. (Verdegaal Bros. v. Union Oil Co. of CA, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131; emphasis provided).

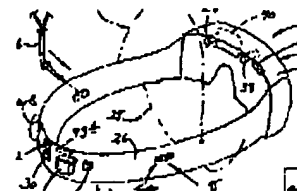
Independent claim 1 recites (and independent claim 20 recites similarly):

head-wearable frame structure adapted for wearing on a subject's head in a condition of positional stability relative thereto, the frame structure including an *integrated* and likewise *positionally stable eye-enclosing portion* configured to control visual input by substantially obstructing the subject's normal visual range[.] (See for example, applicant's FIG. 11 at right.)



Likewise, independent claim 7 recites:

frame structure wearably securable to a subject's head in a manner causing the frame structure to function as a *non-relative-motion unit with respect to the subject's head*, the frame structure comprising an integrated and likewise *non-relative motion*, substantially *vision-obstructing goggle-like portion*[.] (See for example, applicant's FIG. 1 at right.)



The Final Office Action states that the recited limitations are *best shown* in Galiana's FIG. 1, and cites col. 4, lines 17-65. However, applicant respectfully submits that Galiana fails to *expressly or inherently* disclose at least the structural features indicated above.

Galiana Does Not Expressly Disclose the Recited Features

The Office asserts that "the 'eye-enclosing portion' is at least a portion of the HUD's display panels," (5 June 2009 Advisory Action), and "a portion of heads up display 12 as best seen in Figure 1," (Final Office Action, page 3). However, none of Galiana's figures depict any eye-enclosing portions, as would be readily understood by one having skill in the art.

The Offices' asserted 'best evidence', FIG.1 (right) is merely a schematic block diagram depicting a "Target Display 12", and provides *no evidence whatsoever* regarding the *structure* of the Galiana head-worn device(s).

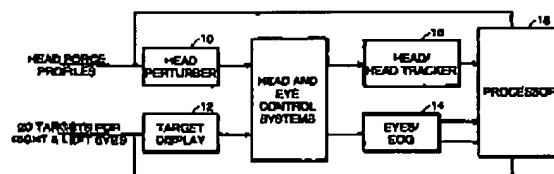


FIG. 1

Likewise, *neither* of Galiana's two depicted devices (FIGS. 3-4, right) include an *eye-enclosing* portion, particularly one that is positionally stable relative to the subject's head (e.g., feature 36 in FIG 3 rotates about the head, and does not enclose the eyes).

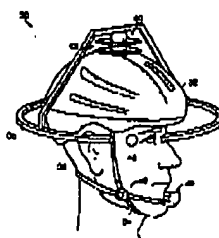


FIG. 3

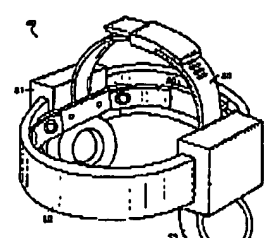


FIG. 4

Therefore, Galiana fails to expressly depict "eye-enclosing" or "positionally stable" structure integral with head-

wearable frame structure.

Likewise, Galiana describes only that:

In accordance with this embodiment...randomized visual targets are presented to the subject, for example, by a Head's Up Display 12. (Col. 4, lines 19-23).

Heads-Up Display 12 preferably includes, by way of example, heads-up dual chromic display panels able to provide randomized retinal errors, the display panels being individually controlled for each eye, with up to ± 40 -degree retinal deviations, (Col. 4, lines 47-52).

However, Galiana entirely fails to *expressly* describe that the HUD, any portion thereof, or any other portion of the depicted and described devices therein, are *eye-enclosing*, or are *integral with head-worn frame structure* such that they are likewise *positionally stable relative to the head*. Nor has the Office indicated in the record any express description of such in Galiana.

Galiana Does Not Inherently Disclose the Recited Features

To establish inherency, the extrinsic evidence *'must* make clear that the missing descriptive matter is *necessarily present* in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.' (*In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); Emphasis provided)

The fact that a certain result or characteristic *may occur or be present* in the prior art is *not sufficient* to establish the inherency of that result or characteristic. (*In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981); Emphasis provided).

One having skill in the art would not consider "a portion of the HUD's display panels" to be *necessarily* 'eye-enclosing', nor to be integrated with a head-worn frame structure in a positionally stable condition relative to the subject's head. Instead, one having skill in the art would recognize a HUD typically involves an image projected onto a 'display panel' that is entirely separate from the viewer's head.

Head-up displays have also been implemented for automobiles. However, such head-up displays *generally utilize the windshield or apparatus attached to the windshield* as the combiner element. (US 5,028,119 to Hegg, et al., 1991; col. 1, lines 39-42; emphasis provided).

Referring to FIGS. 1 and 2 [see right], a vehicle 10 is equipped with...a *head up display* (HUD) system

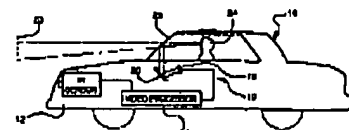
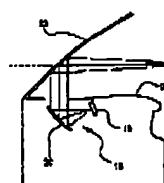


FIG - 1

16 including an image source or display 18 connected to the video processor output, and an aspheric mirror 20 which reflects the display image *to the vehicle windshield 22* [.] (US 5,414,439 to Groves et al., 1995; col. 2, lines 45-53; FIG. 2; emphasis provided).

FIG - 2



An HUD as understood in the art is not at all positionally stable *relative to* the user's head or any head-worn structure. One having skill in the art will recognize that an HUD user's head remains free to turn independently from the HUD or any images displayed thereupon, and to track images displayed thereby (e.g., the driver can turn his head to scan HUD images displayed at the windshield). This understanding is consistent with, not contradicted by, Galiana.

[V]isual targets are presented to the subject, for example, by a Head's Up Display 12...*the subject's head is free to assist target tracking*," (col. 4, lines 21-23, 35-36; Emphasis provided).

Although the Office states "[t]he subject is free to move their head *in response to the stimuli*" (5 June 2009 Advisory Action), the statement is not relevant, because it does not relate to or demonstrate a structural arrangement or condition of the HUD relative to the user's head.

If Galiana's HUD was *positionally stable* relative to the subject's head as asserted (which applicant denies), each movement of the subject's head would produce an identical and corresponding movement of the HUD panel and a target presented thereupon. The head movement would not change the position of the target relative to the user's eye. The subject's head movement would *necessarily fail* to "assist target tracking", contrary to Galiana's express description. For head movement to assist target tracking, as described in Galiana, the HUD display must necessarily be *positionally independent* from the subject's head, not positionally stable relative thereto. Thus, the Office's assertion contains clear factual and legal error.

Likewise, one having ordinary skill in the art will recognize that an image displayed by an HUD does not *necessarily* "substantially obstruct the subject's normal visual range" as recited in the independent claims. As understood regarding HUDs in the art,

Display of vehicle instrument data in a head-up mode (head-up display or HUD) against the view through the windscreen may be achieved by placing a dichroic reflector in front of the windscreen...the pilot may simultaneously see through the dichroic reflector and thus have a *relatively unobstructed view* through the windscreen. (US 4,439,755 to LaRussa, 1984; col 1, lines 39-57; emphasis provided)

The record includes no evidence supporting the Office's position that Galiana's HUD is inherently (*necessarily*) eye enclosing, or positionally stable relative to the subject's head, or that it substantially obstructs the subject's normal visual range.

"The standard of review applied to findings of *fact* is the "substantial evidence" standard under the Administrative Procedure Act (APA)". See *In re Gartside*, 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1775 (Fed. Cir. 2000). See also MPEP § 1216.01.

Therefore, Galiana also does not '*make clear* that the missing descriptive matter (e.g., "eye-enclosing", "positionally stable relative to the user's head", etc.) is *necessarily present* in the thing described".

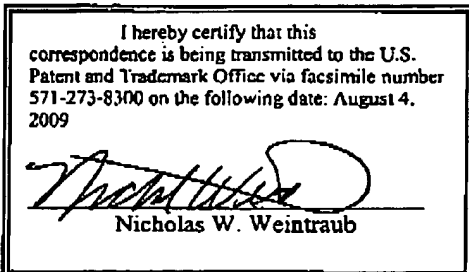
Applicant respectfully submits that the rejection of independent claims 1, 7, and 20 in the Office Action are based upon clear factual and legal error. Because Galiana neither expressly nor inherently (*necessarily*) discloses numerous structural features of applicant's independent claim 1 as discussed above, no *prima facie* basis exists in the record for the asserted rejections of independent claims 1, 7, or 20, nor any claim respectively depending therefrom.

Rejections Under 35 U.S.C. § 103

Claims 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Galiana in view of Densert et al (US 6,159,171). Claims 3-6 depend from and include the distinct limitations of independent claim 1. The combined references fail to teach or fairly suggest the unique features discussed above, and the Final Office Action does not assert that Densert compensates for the failures of Galiana in this regard. For at least this reason, applicant submits claims 3-6 are likewise allowable, and request withdrawal of the rejections therefrom.

Conclusion

In light of the arguments set forth herein, applicant respectfully submits that all rejections asserted in the Final Office Action are shown herein to be based upon clear factual and legal errors, and that a *prima facie* case is not established to support the rejections. Applicant therefore respectfully requests that all claims be allowed without further undue delay.



Respectfully submitted,

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